

REMARKS

I. Introduction

Claims **1-40** are currently pending in the present application. Claims **1, 15-17, 19-21, and 34** are independent. All pending claims stand rejected. In particular:

(A) claims **1, 3, 7-10, 12, 14-15, 17-24, 26, 28-32, 34-37, and 39-40** stand rejected under 35 U.S.C. §102(e) as being allegedly unpatentable over U.S. Patent No. 7,010,512 (hereinafter “Gillin”); and

(B) claims **2, 4-6, 11, 13, 16, 25, 27, 33, and 38** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Gillin in view of U.S. Patent No. 5,945,653 (hereinafter “Walker”).

Upon entry of this amendment, which is respectfully requested, claims **1-5, 7-8, 10, 12, 15-17, 19-21, 23-25, 27, 29-32, 34, 37, and 39** will be amended *solely* for purposes of updating due to recent developments in case law, to provide minor clarifications, and/or to correct informalities (*i.e.*, not for purposes related to any art of record), claims **6** and **9** will be canceled without prejudice or disclaimer, and new claims **41-45** will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.114.

II. Comments on the Examiner’s Response to Arguments

The Examiner states that Applicants argue that neither Gillin nor Walker teach or suggest various features. Final Office Action, pg. 3, 10-11 lines from the bottom. Applicants respectfully note that no such allegation has been made by Applicants. Instead, Applicants have argued that Gillin fails to teach or suggest various pending claim limitations, and that the Examiner’s §103(a) rejections over Gillin in view of Walker fail because of the deficiencies of Gillin, as well as because of the lack of findings and evidence required to establish a *prima facie* case of obviousness (*e.g.*, no reason to combine has been provided).

III. The Examiner's Rejections

A. 35 U.S.C. §102(e) - Gillin

Claims 1, 3, 7-10, 12, 14-15, 17-24, 26, 28-32, 34-37, and 39-40 stand rejected under 35 U.S.C. §102(e) as being allegedly unpatentable over Gillin. As claim 9 is cancelled herein, this ground of rejection is *moot* with respect thereto. Applicants traverse this ground for rejection with respect to all pertinent remaining claims (claims 1, 3, 7-8, 10, 12, 14-15, 17-24, 26, 28-32, 34-37, and 39-40) as follows.

1. **The reference fails to teach or suggest:** *receiving, by the controller and from the applicant, information identifying a substitute form of collection associated with the applicant* (claims 1, 3, 7-8, 10, 12, 14-15, 17-19, 21-24, 26, and 28-32)

Applicants respectfully assert that Gillin fails to teach or suggest limitations of claims 1, 3, 7-8, 10, 12, 14-15, 17-19, 21-24, 26, and 28-32. For example, Gillin fails to teach or suggest *receiving, by the controller and from the applicant, information identifying a substitute form of collection associated with the applicant*.

The Examiner asserts that Gillin teaches allowing a transfer instrument to be linked to an account so that supplemental funds may be provided into the transfer instrument, and that such a teaching is equivalent to the above-quoted limitation. Final Office Action, pg. 3, last paragraph.

Applicants respectfully disagree and respectfully point out that the Examiner appears to seriously misconstrue the above-quoted limitation and/or the teachings of Gillin. Even if the Examiner's allegation of what Gillin teaches were true (which Applicants do not address at this time), the asserted teaching would not read on the above-quoted limitation.

Gillin, according to the Examiner's interpretation, for example, describes allowing a transfer instrument to be created and funded on behalf of another, and also allowing such transfer instrument to be replenished via funds from another account. In other words, even under the Examiner's interpretation of Gillin, an account is created and

credited, and then the **same account** is again credited – the two credit amounts originating from different sources.

In stark contrast to creating an account and having it twice credited, the above-quoted limitation describes (*e.g.*, in combination with the other limitations that comprise the above-noted claims) crediting an account (*e.g.*, a new account) in the case that an application to open the account is approved, and, in the case that the application is *not* approved, **crediting a different account** (*e.g.*, a substitute form of collection – the credited amount being “collected” by the seller).

Thus, even if the Examiner’s assertions were given the most weight and deference possible, it is quite clear that crediting a single account from different sources is fundamentally different than conditionally crediting one of two accounts.

Accordingly, at least because Gillin fails to teach or suggest *receiving, by the controller and from the applicant, information identifying a substitute form of collection associated with the applicant*, Gillin fails to anticipate claims **1, 3, 7-8, 10, 12, 14-15, 17-19, 21-24, 26, and 28-32**.

Applicants therefore respectfully request that this §102(e) ground for rejection of claims **1, 3, 7-8, 10, 12, 14-15, 17-19, 21-24, 26, and 28-32** be **withdrawn**.

2. The reference fails to teach or suggest: *receiving, by the controller and from the applicant, an authorization to credit a second payment amount using the substitute form of collection if the application is declined, wherein the second payment amount is less than the first payment amount* (claims **20, 34-37, and 39-40**; generally)

Applicants respectfully assert that Gillin fails to teach or suggest limitations of claims **20, 34-37, and 39-40**. For example, Gillin fails to teach or suggest *receiving, by the controller and from the applicant, an authorization to credit a second payment amount using the substitute form of collection if the application is declined, wherein the second payment amount is less than the first payment amount*.

As described in Section III.A.1 herein, the Examiner misconstrues the comparison between the alleged teachings of Gillin and the claimed embodiments. Specifically, the

Examiner inappropriately equates the alleged ‘second’ account in Gillin from which funds may be allegedly pulled to replenish the transfer instrument to the “substitute form of collection” recited in the above-quoted limitation.

The ‘second’ account asserted by the examiner to exist in Gillin can simply not be described as a “substitute form of collection”. The ‘second’ account as described by the Examiner is simply not described as “collecting” anything – no credits or deposits are described as being made to such account. Instead, the Examiner only asserts that the alleged ‘second’ account can be used to fund another account – *i.e.*, money is withdrawn or debited from the ‘second’ account. This is the **opposite** of crediting or depositing.

Nor does the Examiner address how Gillin is believed to read on the above-quoted limitation where the ‘second’ account is “credited” if the application is declined. The “application”, as interpreted by the Examiner, is the ‘application’ in Gillin for the transfer instrument. Is the alleged ‘second’ account in Gillin credited if the application for the transfer instrument is declined? The Examiner has set forth no argument, reasoning, or evidence supporting the contention that Gillin teaches or suggests such a feature.

Accordingly, at least because Gillin fails to teach or suggest *receiving, by the controller and from the applicant, an authorization to credit a second payment amount using the substitute form of collection if the application is declined, wherein the second payment amount is less than the first payment amount*, Gillin fails to anticipate claims **20, 34-37, and 39-40**.

Applicants therefore respectfully request that this §102(e) ground for rejection of claims **20, 34-37, and 39-40** be **withdrawn**.

B. 35 U.S.C. §103(a) - Gillin, Walker

Claims **2, 4-6, 11, 13, 16, 25, 27, 33, and 38** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Gillin in view of Walker. Dependent claims **2, 4-5, 11, 13, 25, 27, 33, and 38** are believed patentable at least for depending upon patentable base claims (claims **1, 21, and 34**) and at least for the reasons described herein with respect thereto. As claim **6** is cancelled herein, this ground of rejection is *moot* with

respect thereto. Applicants traverse this ground for rejection with respect to independent claim **16** as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to show how every element of claim **16** is taught or suggested by the cited references and the Examiner has entirely failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth a valid reason that would have led one of ordinary skill in the art to combine the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) The Examiner has failed to establish that the references teach or suggest: *receiving, by the controller and from the seller, information identifying a substitute form of collection and an authorization to credit a second payment amount that is less than the first payment amount to the substitute form of collection*

Applicants respectfully assert that the Examiner has failed to establish that Gillin and Walker, alone or in combination, teach or suggest limitations of claim **16**. For example, the Examiner has failed to establish that Gillin and Walker teach or suggest *receiving, by the controller and from the seller, information identifying a substitute form of collection and an authorization to credit a second payment amount that is less than the first payment amount to the substitute form of collection*.

As described in Section III.A.1 and Section III.A.2 herein, the Examiner has misinterpreted Gillin and has accordingly failed to show how every element of the claimed embodiments is taught or suggested by the cited reference. Specifically, the Examiner has at least failed to show how Gillin teaches or suggests utilizing a “substitute form of collection”; as claimed. Nor does the Examiner provide any evidence that Walker makes up for this deficiency of Gillin.

Accordingly, at least because the Examiner has failed to establish that Gillin and Walker teach or suggest *receiving, by the controller and from the seller, information*

identifying a substitute form of collection and an authorization to credit a second payment amount that is less than the first payment amount to the substitute form of collection, the Examiner has failed to establish that Gillin and Walker render obvious claim **16**, and has accordingly failed to establish a *prima facie* case of obviousness.

Applicants therefore respectfully request that this §103(a) ground for rejection of claim **16** be **withdrawn**.

b) No Reason to Combine is Evident

Even if the Examiner had properly established that the cited references taught or suggested each limitation of claim **16**(which Applicants maintain is not the case), the Examiner has failed to establish a *prima facie* case for obviousness for claim **16**, at least because the Examiner has provided no valid argument, much less evidence (much less substantial evidence) that there would have been **some reason** for someone of ordinary skill in the art to combine the cited references to read on the pending claims.

In this case, the Examiner alleges that because both Gillin and Walker are directed to using “credit accounts”, that “the Examiner found reason to combine the references.” Final Office Action, pg. 5, lines 1-2. Applicants respectfully request that the Examiner provide the “reason” that the Examiner has “found”, on the record. It is not enough that two references be in the same art (which Applicants do *not* concede is the case with Gillin and Walker). Every statute, regulation, guidance document, and court case (yes, even *KSR*) reaffirms the requirement that there must have been, at the time of invention, some reason that one of ordinary skill in the art would have had to combine the specific references chosen by the Examiner, in the specific manner suggested. The Examiner has provided no such reason here.

Instead, the Examiner appears to assert, based solely on the premise that the two cited references are from the same field, that, ten (10) years after the effective filing date of this case, the Examiner has, after reading Applicants disclosure, “found” some reason to both select and combine the cited references to read on the claimed embodiments. This is the epitome of hindsight reconstruction.

Accordingly, at least because the Examiner has (i) failed to show how every limitation of claim **16** is taught or suggested, (ii) failed to provide a proper reason to combine the cited references, and (iii) failed to support any reason to combine by evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claim **16**.

Applicants therefore respectfully request that this §103(a) ground for rejection of claim **16** be **withdrawn**.

c) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved any of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine Gillin and Walker to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claim **16** should therefore be **withdrawn**.

IV. New Claims

New claims **41-45** are believed to be patentable over the cited references at least for the reasons otherwise presented herein. Further, after reviewing the cited references,

Applicants believe that the Examiner has failed to show how the cited references teach, suggest, or render obvious, alone or in combination, at least:

(i) *receiving, from a seller, information descriptive of a product that the seller desires to sell via the on-line intermediary (claims 41-45);*

(ii) *receiving, from the seller, an authorization for the on-line intermediary to credit a sale price of the product and an incentive amount to the new financial account, in the case that the application for the new financial account is approved and in the case that the product is sold via the on-line intermediary (claims 41-45);*

(iii) *receiving, from the seller, an authorization for the on-line intermediary to credit the sale price of the product to the existing financial account, in the case that the application for the new financial account is declined and in the case that the product is sold via the on-line intermediary (claims 41-45);*

(iv) *crediting, upon a sale of the product to a buyer in exchange for the sale price, and in accordance with the authorizations received from the seller, an appropriate monetary amount to an appropriate one of the financial accounts (claims 41-45);*

(v) *wherein the indication descriptive of whether the application is accepted or declined comprises an indication that the application is accepted, and wherein the crediting of the appropriate monetary amount to the appropriate one of the financial accounts comprises crediting the sum of the sale price and the incentive amount to the new financial account (claims 42-43);*

(vi) *wherein the incentive amount comprises a new financial account bounty received by the on-line intermediary from the financial institution, minus a fee for having the seller's product listed for sale via the on-line intermediary (claim 43);*

(vii) *wherein the indication descriptive of whether the application is accepted or declined comprises an indication that the application is declined, and wherein the crediting of the appropriate monetary amount to the appropriate one of the financial accounts comprises crediting only the sale price to the existing financial account (claim 44); or*

(viii) *wherein the indication descriptive of whether the application is accepted or declined comprises an indication that the application is declined, and wherein the crediting of the appropriate monetary amount to the appropriate one of the financial*

accounts comprises crediting the sale price minus a fee for having the seller's product listed for sale via the on-line intermediary, to the existing financial account (claim 45).

V. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Final Office Action does not imply agreement with those comments.

If there remain any questions regarding the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number (203) 461-7017 or via e-mail at cfincham@walkerdigital.com, upon the Examiner's convenience.

VI. Fees and Petition for Extension of Time to Respond

Enclosed herewith is the appropriate **\$810.00** fee for filing of a Request for Continued Examination (RCE), for which this Amendment is an RCE Submission, as well as the surcharge fee of **\$376.00** for filing one (1) independent claim and three (3) total claims in excess of the highest amounts previously paid for.

Applicants also hereby petition for a **two-month extension** of time and authorize the charge of **\$490.00** to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

Furthermore, should any other extension of time be required or any other fee be due, please grant any extension of time which may be required to make this Amendment timely, and please charge any required fee to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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